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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,260	11/02/2001	Roberto Perelman	07844-501001	5097
21876	7590	01/27/2005	EXAMINER	
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA MINNEAPOLIS, MN 55402			TIV, BACKHEAN	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N	Applicant(s)	
	10/006,260	PERELMAN ET AL.	
	Examiner	Art Unit	
	Backhean Tiv	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 November 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-40 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

Detailed Action

Claims 1-40 are pending in this application.

Information Disclosure Statement

The information disclosure statement filed 11/02/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1-15,32-40 recites the limitation, "modify the electronic document's predetermined final format at the client". If the electronic document is already in a final format, then how can it be modified. The American Heritage College Dictionary defines final as not to be changed or reconsidered; unalterable. The applicant is advised to take out the word "final" to have the claim read "predetermined format".

Claims 4, 19, 29, 35, recites limitations "adding final format information to the electronic document without changing the pre-existing final format information

in the electronic document". This claim limitation is unclear. By adding data to the electronic document, the document is being changed.

Claims 16-23 recites the limitation "the server data", "the received data", "the received instructions". There is insufficient antecedent basis for this limitation in the claim.

The term "a relative order" in claims 6,21,24-31,37 is a relative term which renders the claim indefinite. The term "a relative order" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,026,433 issued to D'Arlach et al(D'Arlach).

As per claim 1, 16, 24, 32, D'Arlach teaches a machine-implemented method of modifying an electronic document(Abstract), the method comprising: receiving a request from a client(Abstract, Fig.2);

producing data corresponding to the client request(Abstract, Fig.2); generating instructions to modify an electronic document defining visual information to be displayed(Abstract, Fig.4,8-14), the generated instructions specifying one or more operations to modify the electronic document at the client to accommodate the produced data(Abstract, Fig.4), and the generated instructions including at least one tag indicating a relative order in which the produced data is to be imported into the electronic document and the instructions are to be performed(Abstract, Fig.4,6,8-14); and

transmitting the produced data and the generated instructions to the client(Abstract).

As per claim 2, 33, wherein the produced data includes a location from which the client is to retrieve the electronic document(Abstract, fig.2).

As per claim 3, 34 wherein the produced data includes a file name for the electronic document, which is already locally accessible by the client(col.5, lines 46-55).

As per claim 4, 19,29,35, wherein the operations to modify the predetermined final format at the client comprise adding final format information to the electronic document without changing pre-existing fmal format information in the electronic document(col.5, lines 46-55).

As per claim 5, 20,30,36 wherein the generated instructions comprise a script(Fig.4).

As per claim 6, 21, 37, wherein the generated instructions further comprise at least one tag indicating a relative order in which the produced data is

to be imported into the electronic document and the instructions are to be performed(Fig.4, 7-13).

As per claim 7, 22, 38 wherein the at least one tag is a before tag, an after tag or a document tag, wherein the before tag indicates that the produced data is to be imported into the electronic document before the instructions are performed, the after tag indicates that the produced data is to be imported into the electronic document after the instructions are performed, and the document tag indicates that at least a portion of the generated instructions are to be inserted into the electronic document(Fig.4, 7-13).

As per claim 8, 23,31,39, wherein the electronic document comprises a form document including one or more form fields, which are responsive to user actions(Fig.4, 7-13).

As per claim 9, 40, wherein adding the final format information causes a new visual object to overlay one or more pre-existing visual objects in the electronic document(Fig.4, 7-13).

As per claim 10, the method of claim 8, wherein the generated instructions are specific to the electronic document, and the operations to modify the predetermined final format at the client result in one or more of the following document changes: field identity change, field location re-arrangement, and field content change(Fig.4, 7-13).

As per claim 11, the method of claim 8, wherein the client comprises a device having a memory storing the electronic document(Fig.2).

As per claim 12, the method of claim 8, wherein the client comprises a software application(Fig.2).

As per claim 13, the method of claim 8, wherein the client request comprises a database search request, and wherein producing data comprises retrieving data from a database(Abstract, Fig.2).

As per claim 14, the method of claim 8, wherein producing data comprises generating data using scripts(Fig.4, 7-13).

As per claim 15, the method of claim 8, wherein generating instructions comprises: retrieving initial instructions(Abstract); and customizing the initial instructions to be specific to the electronic document(Fig.4, 7-13).

As per claim 17, the method of claim 16, wherein obtaining the electronic document comprises receiving the electronic document(Abstract).

As per claim 18, the method of claim 16, wherein obtaining the electronic document comprises retrieving the electronic document as directed by the instructions(Fig.4, 7-13).

As per claim 25, the method of claim 24, wherein the at least one tag indicates that the produced data is to be imported into the electronic document before the instructions are performed(Fig.4-13).

As per claim 26, the method of claim 24, wherein the at least one tag indicates that the produced data is to be imported into the electronic document after the instructions are performed(Fig.4-13).

As per claim 27, the method of claim 24, wherein the at least one tag indicates that at least a portion of the generated instructions are to be inserted into the electronic document(Fig.4-13).

As per claim 28, the method of claim 24, wherein the at least a portion of the generated instructions result in dynamically set preference settings for the electronic document(Abstract, Fig.4-13).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2151

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BT
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2151
1/13/05


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PERVISORY PATENT EXAMINER